

## REMARKS

### Response

Claims 4 and 21-24 are currently pending. Claims 4 and 21-24 have been rejected. Claims 1-3 and 5-10 were previously canceled. Claims 11-20 were not entered. Examiner has withdrawn the allowability of claim 4 in view of a new ground of rejection. Applicants have amended claim 4 for purposes of clarity and not for reasons necessitated by any requirements of the patent laws. The subject matter of the amended claim is supported by the specification and no new matter is added. For example, support for the amendment can be found in the drawings. Applicants respectfully submit that the patent application and the claims, as amended, are in a condition for allowance. Reconsideration is respectfully requested.

### Claim Rejections

#### **Rejections Pursuant to 35 U.S.C. § 102**

The Examiner has rejected claims 4 and 23-24 pursuant to 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 3,054,585 to Roberts et al. (hereinafter, "Roberts et al."). Specifically, the Examiner alleges that Roberts et al. teach an adjustable one-piece molded clamp comprising a first jaw (114), a second jaw (13) and a tension strap (110) each unitarily formed with the first jaw, and at least two notches (15) on the outward facing surface of the second jaw. *See* Office Action mailed 03/24/06, page 2. Further, the Examiner alleges that strap has at least one through aperture having an inner edge that is able to be releasably engaged with at least one of the notches. *Id.* Finally, Examiner alleges that the first and second jaws further comprise means to mount (112) the clamp on a surface, and that the clamp is made of polymer. *Id.*

Applicants respectfully traverse the rejection because Roberts et al. do not disclose the adjustable one-piece molded clamp such as the one in Applicants' amended claim 4, described below.

To anticipate a claim pursuant to 35 U.S.C. § 102, the "reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." See PPG Industries v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996) (emphasis added). See also Motorola v. Interdigital Technology Corp., 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997). That is, the reference must expressly or inherently teach the entire claim. Roberts et al. simply do not anticipate the present invention because Roberts et al. neither disclose each and every element of the adjustable clamp claimed in claim 4, nor enable one skilled in the art to make the claimed adjustable clamp.

Applicants' claim 4, as amended, claims an adjustable one-piece molded clamp comprising first and second jaws positioned substantially parallel in a first plane. At least two notches are in the outward facing surface of the second jaw. A tension strap unitarily formed with the first jaw extends from the inward facing surface of the first jaw and has at least one through-aperture that is able to be releasably engaged with at least one of the notches upon passing the first end of the second jaw through the aperture. These limitations of the claimed invention are simply not found in Roberts et al.

Rather, Roberts et al. disclose a clamp comprising "a relatively thin, flexible strap **10** having a plurality of longitudinally spaced apertures or holes **11** therein. The strap terminates in a substantially rigid base portion **12** having a branch **13** projecting therefrom at an angle to the plane of the strap." See Roberts et al., 2:20-25. Thus, Roberts et al. disclose a device having a base and a strap. Nothing in Roberts et al. could be interpreted as being a second jaw and as

such Roberts et al. cannot possibly teach two jaws as is claimed by Applicants. Applicants respectfully point out that Examiner's allegation that element **114** in Roberts et al. is a jaw is a misstatement. Rather, Roberts et al. show that "the base portion **112** secured to the end of the flexible strap is bent at **114** to form a receiving channel for supporting the elongate articles **116**...." *See* Roberts et al., 3:34-37. Thus, **114** is a point at which base **112** is bent. It is not a jaw as suggested by Examiner. As such, Roberts et al. fail to anticipate Applicants' claimed invention because the reference fails to teach each and every element of Applicants' claimed invention.

Furthermore, not only do Roberts et al. fail to teach first and second jaws, they also fail to teach two jaws positioned parallel to each other in the same plane as is claimed in Applicants' amended claim 4. Rather, the clamp disclosed by Roberts et al. only teaches one branch (13). As discussed above, (114) is *not* a jaw but is a point at which base (112) is bent. As shown in Figure 7, base (112) is in a plane perpendicular to branch (13). Thus, Roberts et al. do not teach each and every element of Applicants' claimed invention and therefore cannot anticipate Applicants' claimed invention.

Finally, in contrast to Applicants' claimed invention, the flexible strap **10** cannot extend from the inward facing surface of the first jaw because there is not a jaw from which strap **10** extends. Even if base **112** were deemed to be a jaw, flexible strap does not extend from an inward facing surface of the base. Rather, "the base portion **112** [is] secured to the end of the flexible strap...." *See* Roberts et al., 3:34-35. Therefore, Roberts et al. cannot anticipate Applicants' claimed invention because the reference fails to teach each and every element of Applicants' claimed invention.

For at least the reasons set forth above, Roberts et al. simply cannot anticipate Applicants' amended claim 4 because Roberts et al. fail to disclose each and every element of Applicants' claimed invention. Therefore, Applicants respectfully request withdrawal of the rejection.

Because Roberts et al. do not anticipate the adjustable clamp claimed in independent claim 4, Roberts et al. likewise cannot anticipate the adjustable clamp claimed in claims depending thereon. Therefore, Applicants respectfully traverse the rejection of dependent claims 23-24 and request that the rejection be withdrawn.

Specifically, claim 23 requires the further limitation of the second ends of first and second jaws further comprising means to mount the clamp on a surface. For at least the reasons set forth above, Roberts et al. do not teach an adjustable clamp comprising first and second jaws positioned substantially parallel to each other in the same plane, nor do they teach a tension strap that extends from the inward facing surface of the first jaw. Finally, because Roberts et al. fail to teach two jaws, Roberts et al. cannot possibly teach that second ends of first and second jaws further comprise means to mount the clamp on a surface. As such, any teaching in Roberts et al. with respect to a means to mount the clamp on a surface is moot because the reference fails to teach each and every element of Applicants' claimed invention. Therefore, Applicants respectfully request withdrawal of the rejection.

Claim 24 requires the further limitation that the clamp is made of a polymer. As discussed above, Roberts et al. do not teach an adjustable clamp comprising first and second jaws positioned substantially parallel to each other in the same plane, nor do they teach a tension strap that extends from the inward facing surface of the first jaw. As discussed above, Roberts et al. fail to teach each and every element of Applicants' claimed invention as claimed in

independent claim 4, and therefore any teaching in Roberts et al. with respect to a clamp made of polymer is moot because the reference fails to teach each and every element of Applicants' claimed invention. Therefore, Applicants respectfully request withdrawal of the rejection.

### **Rejections Pursuant to 35 U.S.C. § 103**

The Examiner has rejected claims 21-22 pursuant to 35 U.S.C. § 103 (a) as being allegedly unpatentable over Roberts et al. in view of U.S. Patent No. 6,164,604 to Cirino et al. (hereinafter, "Cirino et al."). Examiner alleges that "Roberts et al. teach the clamp but fail to teach the clamp includes at least one protrusion on the inward facing surfaces of the first and second jaws. Cirino teaches the clamp having at least one protrusion (12) on the inward facing surfaces of the first and second jaws. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added protrusion to Robert et al.'s first and second jaws as taught by Cirino et al. to prevent an object from rotating inside the first and second jaws." *See* Office Action mailed 03/24/06, page 3. As discussed above, Roberts et al. do not teach an adjustable clamp comprising first and second jaws positioned substantially parallel to each other in the same plane, nor do they teach a tension strap that extends from the inward facing surface of the first jaw. For at least these and the reasons set forth below, Applicants respectfully traverse the rejection.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. In re Piasecki, 745 F.2d 1468 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, and of particular importance here, the reference or combination of references must teach or disclose all of the claimed limitations of the

invention. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2143.03. Third, if there is a teaching, suggestion, or incentive, it must motivate the skilled artisan to combine the teachings or suggestions with a reasonable expectation of success. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2143.03. Therefore, it is improper for the Examiner to use the applicant's invention as a blueprint to hunt through the prior art for the claimed elements and then combine them as claimed. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

As described above, Applicants' claimed invention is for an adjustable one-piece molded clamp comprising first and second jaws positioned substantially parallel in a first plane, at least two notches in the outward facing surface of the second jaw, and a tension strap unitarily formed with the first jaw that extends from the inward facing surface of the first jaw and has at least one through-aperture that is able to be releasably engaged with at least one of the notches upon passing the first end of the second jaw through the aperture. As claimed in claim 21, the clamp further comprises at least one protrusion on the inward facing surface of the first and second jaws, and as claimed in claim 22, the at least one protrusion is unitarily formed with the inward facing surface of the first and second jaws.

For at least the reasons set forth above, Roberts et al. do not disclose Applicants' claimed invention. Specifically, the reference fails to disclose an adjustable one-piece molded clamp comprising first and second jaws positioned substantially parallel in a first plane, and further fails to disclose a tension strap unitarily formed with the first jaw that extends from the inward facing surface of the first jaw.

Cirino et al. disclose pipe clamps not unitary first and second jaws positioned substantially parallel to each other in the same plane and a tension strap that extends from the inward facing surface of the first jaw and that has at least one through-aperture through which the second jaw is able to pass. Further, Cirino et al. fail to disclose at least one notch on the second jaw, the tension strap able to be releasably engaged with at least one notch formed in the other jaw. In fact, Cirino et al. disclose that flat bottom **17** and **21** of the main body portion **2** and **3** abutably engage each other. *See* Cirino et al., 4:14-15 and Figure 4. This is in contrast to Applicants' claimed invention in which second jaw **20** passes through the at least one aperture **42** of tension strap **40** such that strap **42** releasably engages at least one of notches **30, 32, 34, 36, 38**. *See* Specification, p. 4, ll. 3-9, and Figures 3-4.

Since Roberts et al. fail to teach all of the elements of Applicants' independent claim 4, on which claims 21-22 depend, the addition of the protrusions of Cirino et al. cannot ameliorate the deficiencies thereof. Therefore, the rejection of claims 21-22 cannot stand because Roberts et al. in view of Cirino et al. would not teach or suggest each and every element of Applicants' claimed invention. Withdrawal of the rejection is respectfully requested.

### Examiner's Response to Applicants' Arguments

Examiner notes that he proposed claim language for claim 4 to place the application in condition for allowance but that Applicants declined. Specifically, Examiner proposed to add "said strap comprising first and second ends and wherein the first end of strap is located below of first jaw and lower than said top part of the jaw." Applicants respectfully point out that prior to Examiner's proposed claim amendment, Examiner already recognized allowable subject matter in claim 4 and therefore the new search that Examiner conducted was unnecessary.<sup>1</sup> As such, claim 4 should be allowed without further amendment.

Applicants respectfully disagreed with Examiner's proposed amendment in an email response dated March 14, 2006, and hereby incorporate by reference the arguments made

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<sup>1</sup> Applicants respectfully wish to remind Examiner that he recommended to Applicants that claim 1 (on which claim 4 originally depended) be amended to include additional details regarding the strap, such as by defining that "the strap is formed inwardly of 1st jaw." See Examiner's Interview Summary of Interview dated June 27, 2005, mailed July 11, 2005. Applicants respectfully disagreed with Examiner that such a limitation was necessary to distinguish Applicants' claimed invention over the prior art. Rather, Applicants amended claim 1 to define "each of said notches being angularly offset from said outward facing surface." See Amendment and Request for Consideration dated July 29, 2005. In the Final Office Action mailed October 17, 2005, Examiner rejected Applicants' claims 1-3 and 5-9, but *objected* to claim 4, noting that "[c]laim 4 is objected to as being dependent upon a rejected base claim, but *would be allowable* if rewritten in independent form including all of the limitations of the base claim and any intervening claims." See Office Action mailed October 17, 2005, page 4 (emphasis added). In response, Applicants filed an Amendment and Request for Consideration, dated November 3, 2005, in which claim 4 was amended to include all of the limitations of claim 1 and any intervening claims. Applicant also added new claim 15. On November 22, 2005, Examiner issued an Advisory Action in which claim 4 was objected to and claims 1-3 and 5-9 were rejected. In a telephonic interview with Examiner on December 1, 2005, Examiner explained to Applicants' representatives that the Advisory Action was based on the Listing of Claims in the July 29, 2005, Amendment and Request for Consideration because the Listing of Claims in Applicants' Amendment and Request for Consideration dated November 3, was not entered after final. Examiner further explained that *if newly added claim 15 was canceled, then claim 4 would be allowed*. In response, Applicants filed an Amendment and Request for Consideration dated January 6, 2006, in which claims 1-3 and 11-20 were canceled. Claim 4 was amended to include all of the limitations of the base claim and any intervening claims, in accordance with Examiner's recognition of allowable subject matter therein. Applicants added new claims 21-24, which should be allowable because they depend from an allowable claim (claim 4). On March 13, 2006, Examiner called Applicants' representatives and indicated that claim 4 would be allowable if amended to include Examiner's proposed claim amendment, described above. On March 14, 2006, Applicants' responded. The arguments set forth by Applicants in the March 14 email are repeated herein.



therein. Specifically, for at least the following reasons, the proposed amendment was unnecessary to distinguish Applicants' claimed invention over Roberts et al. and further was improper based upon Applicants' disclosure.

First, Roberts et al. teach a "thin, flexible strap **10** having a plurality of longitudinally spaced apertures or holes **11** therein. The strap terminates in a substantially rigid base portion **12** having a branch **13** projecting therefrom at an angle to the plane of the strap." *See* Roberts et al., 2:21-25. Thus, Roberts et al. disclose a device having a base and a strap. No part of the device taught by Roberts et al. could possibly be interpreted as being a second jaw and as such, Roberts et al. cannot possibly teach two jaws as is claimed by Applicants. Therefore, because Roberts et al. do not teach or disclose each and every element of Applicants' claimed invention, Applicants' claimed invention is distinguishable over this reference and Examiner's proposed claim amendment is unnecessary.

Second, Applicant respectfully disagrees with Examiner's proposed claim amendment because the claimed device is not designed to work as Examiner has drafted the claim. Applicants' claimed strap extends from the inward facing surface of the first jaw. The strap cannot be located below the first jaw because, referring to Figure 1 of Applicants' specification, first jaw **10** is the entire piece to the left of optional hole **80**. If tension strap **40** were positioned *below* first jaw **10** as Examiner suggests, tension strap **40** would not pass over second jaw **20** and releasably engage at least one of notches **30 - 38**, as is required by Applicants' claimed invention. *See* Specification, page 4, ll. 4-5, stating that "[t]he tension strap is passed over the first end 26 of the second jaw 20."

Additionally, Applicants' specification discloses "[t]ension strap 40 is unitarily formed with the first jaw 10 and, in a preferred embodiment, the tension strap extends from the inward facing surface 12 of the first jaw 10." *See* Specification, page 3, ll. 23-25. No where does Applicant disclose that "the first end of strap is located below of the first jaw and lower than the top part of second jaw." Therefore, Applicants respectfully point out that the Examiner's proposed amendment is not possible for at least the reasons that the device is not designed to work as defined by Examiner and the specification does not support such an amendment.

For at least the reasons outlined above, Applicants' respectfully disagree that claim 4 requires additional amendment in order to distinguish Applicants' claimed invention over Roberts et al. or any cited prior art, alone or in combination.

Applicants respectfully request that the rejection be withdrawn and claims 4 and 21-24 allowed.

### **Conclusion**

Applicants respectfully submit that the patent application and the claims, as amended, are in a condition for allowance. Accordingly, reconsideration and allowance of the claims is respectfully requested.


Applicants would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

*Serial No. 10/608,735*  
*Amendment Dated June 26, 2006*  
*Reply to Office Action of March 24, 2006*

The Commissioner is hereby authorized to charge Deposit Account No. 03-2026 for any fees associated with this Amendment and Response.

Respectfully submitted,

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